

### Remarks

Applicants believe the present Amendment places the application in condition for allowance. If upon consideration of the present Amendment the Examiner is not inclined to allow the present application, entry of the present amendment is still requested as Applicants believe that the present Amendment at least places the application in better form for appeal.

By the present amendment and response, Applicants have cancelled claims 27-34, without prejudice to Applicants' ability to prosecute the same or substantially similar claims in a (separate) continuing application claiming priority to the present application. Claims 2, 4, and 5 were cancelled previously. No changes to any of the remaining claims have been made. Accordingly, claims 1, 3, and 6-26 are pending in the present application, with claims 1, 13, 21, and 24 being independent claims.

Remarks addressing the §103(a) contained in the Office Action mailed April 14, 2005 are set forth in turn below.

#### I. Claim Rejections Under 35 U.S.C. § 103(a)

##### A. Rejection of claims 27-30 and 33-34

Claims 27-30 and 33-34 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable for obviousness over Ocvirk (Analyt. Meth. Instrumentation 1995) in view of Shimada (U.S. 4,137,161) and Hu (U.S. 6,623,860). Since claims 27-30 and 33-34 have been cancelled herewith, the obviousness rejection is moot.

B. Rejection of claim 31

Claim 31 was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable for obviousness over Ocvirk (Analyt. Meth. Instrumentation 1995) in view of Shimada (U.S. 4,137,161) and Hu (U.S. 6,623,860). Since claim 31 has been cancelled herewith, the obviousness rejection is moot.

C. Rejection of claims 1, 3, 6-12, and 21-23

Claims 1, 3, 6-12, and 21-23 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable for obviousness over Ocvirk (Analyt. Meth. Instrumentation 1995) in view of Shimada (U.S. 4,137,161) and in view of Koehler (U.S. 6,814,859).

The Examiner asserted that Koehler constitutes prior art under 35 U.S.C. 102(e) based on the earlier effective U.S. filing date of the reference, but noted that this rejection might “be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person [pursuant to] MPEP §§ 706.02(I)(1) and 706.02(I)(2).”

A “Declaration of Stephen D. O’Connor In Support of Response to Official Action Mailed April 14, 2005” (“O’Connor Decl.”) is submitted herewith as evidence that the subject matter of the reference and the claimed invention were, at the time the invention was made subject to an obligation of assignment to the same person. In particular, all inventors of both Koehler and the present applications were required at the time of invention to assign their interests commonly to Nanostream, Inc. (O’Connor Decl. at ¶¶ 2-4). As a result, Koehler does not constitute prior art under 35 U.S.C. 103(c).

Since all elements of claims 1, 3, 6-12 and 21-23 are not shown in the cited references without Koehler, and Koehler does not constitute prior art that can support the present rejections, withdrawal of the § 103(a) rejections as to claims 1, 3, 6-12, and 21-23 is respectfully requested.

D. Rejection of claims 24-26

Claims 24-26 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable for obviousness over Ocvirk (Analyt. Meth. Instrumentation 1995) in view of Shimada (U.S. 4,137,161) and in view of Koehler (U.S. 6,814,859) as applied to claim 1, further in view of Soga (US 2003/0230524 A1).

The Examiner asserted that Koehler constitutes prior art under 35 U.S.C. 102(e) based on the earlier effective U.S. filing date of the reference, but noted that this rejection might “be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person [pursuant to] MPEP §§ 706.02(I)(1) and 706.02(I)(2).”

A “Declaration of Stephen D. O’Connor In Support of Response to Official Action Mailed April 14, 2005” (“O’Connor Decl.”) is submitted herewith as evidence that the subject matter of the reference and the claimed invention were, at the time the invention was made subject to an obligation of assignment to the same person. In particular, all inventors of both Koehler and the present applications were required at the time of invention to assign their interests commonly to Nanostream, Inc. (O’Connor Decl. at ¶¶ 2-4). As a result, Koehler does not constitute prior art under 35 U.S.C. 103(c).

Since all elements of claims 24-26 are not shown in the cited references without Koehler, and Koehler does not constitute prior art that can support the present rejections, withdrawal of the § 103(a) rejections as to claims 24-26 is respectfully requested.

E. Rejection of claims 13-15 and 20

Claims 13-15 and 20 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable for obviousness over Ocvirk (Analyt. Meth. Instrumentation 1995) in view of Shimada (U.S. 4,137,161) as applied to claim 27, further in view of Soga (US 2003/0230524 A1). Notably, each of claims 13-15 require, *inter alia*:

“at least one **porous membrane** disposed downstream of the plurality of optical detection regions...”

In all of the Examiner’s prior rejections relating to claims requiring a “porous membrane,” the Examiner relied **exclusively upon Koehler** (U.S. 6,814,859) to establish the existence of a porous membrane in the prior art (which reference does not qualify as prior art for purposes of 35 U.S.C. § 103(a) as established previously herein). In the present rejection, the Examiner fails to identify any reference that teaches a “porous membrane disposed downstream of a plurality of optical detection regions,” as required by claims 13-15 and 20. Applicants discussion of Shimada and Soga in previous amendment(s) is hereby incorporated by reference. In short, neither Shimada nor Soga teach or suggest the use of a porous membrane disposed downstream of any optical detection region(s). Ocvirk similarly lacks any teaching of a porous membrane disposed downstream of any optical detection region(s). In fact, Ocvirk contains no mention at all of the term “membrane.”

Applicants respectfully submit that any combination of Ocvirk, Shimada, and Soga fails to teach all of the limitations of the claims (i.e., a porous membrane disposed downstream of any optical detection region(s)), as is required by MPEP § 2143.03 to support a *prima facie* case of obviousness and related rejection under 35 U.S.C. § 103. Since Ocvirk, Shimada, and Soga fail to teach all of the limitations of claims 13-15 and 20, withdrawal of the 103(a) rejections thereof is respectfully requested.

F. Rejection of claims 16-19

Claims 16-19 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable for obviousness over Ocvirk (Analyt. Meth. Instrumentation 1995) in view of Shimada (U.S. 4,137,161) and in view of Soga (US 2003/0230524A1) as applied to claim 13, further in view of Hu (U.S. 6,623,860). Since all of these claims 16-19 depend, whether directly or indirectly, from claim 13, each require, *inter alia*:

“at least one **porous membrane** disposed downstream of the plurality of optical detection regions...”

All of the arguments made in connection with claims 13-15 and 20, above, are hereby incorporated by reference. Specifically, none of Ocvirk, Shimada, Soga, or Hu disclose a “porous membrane disposed downstream of a plurality of optical detection regions” as claimed by claims 16-19 and as would be required by MPEP § 2143.03 to support a *prima facie* case of obviousness and related rejection under 35 U.S.C. § 103. Since Ocvirk, Shimada, Soga, and Hu fail to teach all of the limitations of claims 16-19, withdrawal of the 103(a) rejections thereof is respectfully requested.

**Conclusion**

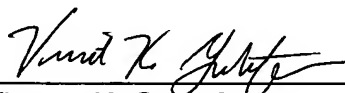
By virtue of the amendments and arguments provided herein, Applicants believe that all pending claims 1, 3, and 6-36 are in good condition for allowance, and respectfully request the allowance of these claims.

Please note that the correspondence address for this application and Customer Number 32763 was recently changed to an address in Research Triangle Park, North Carolina.

If any additional information should be required in considering this Response, or if there are any questions or deficiencies with regard to this Response that can be addressed by telephone, the USPTO representative is encouraged to contact the undersigned directly at (919)419-9350.

Respectfully submitted,

Dated: April 29, 2005

  
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Vincent K. Gustafson  
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**USPTO Customer No.: 32763**

Encl: Declaration of Stephen D. O'Connor in Support of Response to Official Action  
Mailed April 14, 005